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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,536	09/29/2003	Matthew G. Goulet	29641/39623	1848
4743	7590	11/08/2004		
MARSHALL, GERSTEIN & BORUN LLP 6300 SEARS TOWER 233 S. WACKER DRIVE CHICAGO, IL 60606			EXAMINER NGUYEN, GEORGE BINH MINH	
			ART UNIT 3723	PAPER NUMBER

DATE MAILED: 11/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/673,536

Applicant(s)

GOULET ET AL.

Examiner

George Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 8-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6 and 7 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date January 05, 2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Receipt is acknowledged of Applicant's election of Specie I, Figures 1-4, claims 1-7.

Please note that claims 15-17 read on Figures 8-11 which show spring clamp on both ends of the base. Thus, claims 8-20 were withdrawn from further consideration.

Claims 1-7 are presented for examination.

Receipt is acknowledged of the IDS filed on January 05, 2004 which have been considered and placed of record in the file.

This application has been filed with formal drawings which are acceptable to the examiner.

### ***Election/Restrictions***

Applicant's election without traverse of Species I, Figures 1-4, claims 1-7 in the reply filed on September 20, 2004 is acknowledged. Please note that claims 15-17 read on Figures 8-11 which show spring clamp on both ends of the base. Thus, claims 8-20 were withdrawn from further consideration.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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3. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: an abrasive element since the claims are directed to an abrading tool.

Regarding to claim 5, in according to Figure 3, the ledge 52 is shown extending from handle 26. Therefore, it is incorrect to claim that ledge 52 extends from the base ends as set forth in the claim. Correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

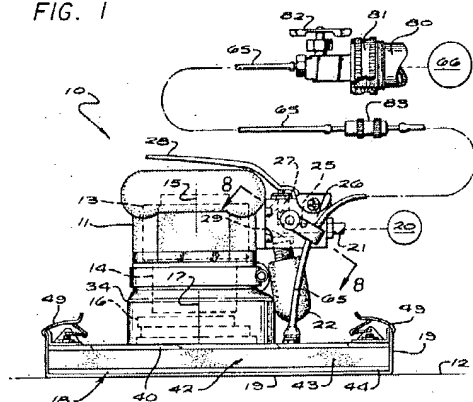
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4, and 6-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Hutchins' 5,022,190.

With reference to Figure 1, col. 3, lines 1-22, Hutchins discloses the claimed invention.

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FIG. 1



bly formed of two layers of resiliently deformable material, including a relatively thick upper layer 43 and a thinner bottom layer 44, both of which are of the same rectangular horizontal section as top backing plate 40. Layer 43 is desirably made of a resiliently deformable closed pore resinous plastic foam, such as polyurethane foam or the like. The upper horizontal surface 45 of foam layer 43 may be bonded to the horizontal undersurface 46 of the more rigid backing plate 40. The bottom layer 44 of cushion 42 is typically formed of a sheet of fabric backed vinyl material, tightly and permanently bonded to the horizontal undersurface 47 of layer 43, and has a horizontal undersurface 48 which engages and applies downward force to the sandpaper sheet 19. The layer or sheet 44 is resiliently deformable with upper layer 43 and the sandpaper sheet, to maintain the sandpaper continuously in contact with the work surface during a sanding operation. Sandpaper 19 may be secured adhesively to the underside of bottom sheet 44 of the sanding pad, or may be releasably secured to the pad by spring clips 49 of any known type attached to opposite ends of backing plate 40.

Please note that spring clip 49 has a cam surface at the end of pivot arm. The end cam surface applies a compressive force against the base 42 to hold the sand paper 19 onto the base.

### ***Allowable Subject Matter***

6. Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Earl et al.'761, Johnson'396, Tully et al.'099, Vogel et al.'793, Malyuk'375, Dicke'317, Butts'310, Walz et al.'072 all disclose sanding apparatus with pivotally engaged sandpaper holder.

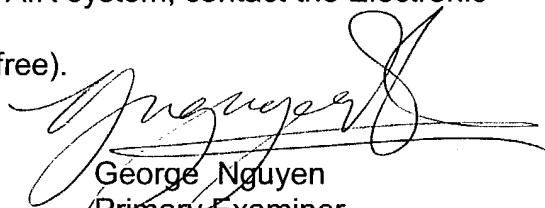
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Nguyen whose telephone number is 703-308-0163. The examiner can normally be reached on Monday-Friday/630AM-300PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 703-308-2687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**GEORGE NGUYEN**  
**PRIMARY EXAMINER**



George Nguyen  
Primary Examiner  
Art Unit 3723

GN – November 04, 2004